REMARKS

Claims 1-14 and 16-27 are pending in the present application. Claim 15 was canceled; and claims 1, 13, 14, 18, and 23- 27 were amended. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 103, Obviousness, claims 1-2, 9-12, 23 and 26-27

The examiner has rejected claims 1-2, 9-12, 23 and 26-27 under 35 U.S.C. § 103 as being unpatentable over Nochur et al., U.S. Patent Number 5,835,758 ("*Nochur*") in view of Hager et al., U.S. Patent Number 5,247,661 ("*Hager*"). This rejection is respectfully traversed.

In rejecting the claims, the examiner stated the following:

> With respect to claim 1, Nochur discloses receiving a user input selecting the text from the electronic book to form selected text (the user enters the text document and selects the desired text to be transferred: col. 7, lines 42-65 and col. 11, lines 42-53).
>
> Nochur discloses a distributed computer system comprising a plurality of computer-based documents, which can be shared among various users on the network. The text document or selected text can be sent or forwarded to other users or recipients who are listed from a list of people available in database and are selected by the sender (col. 9, lines 65-67 and col. 10, lines 1-10). Nochur does not explicitly teach automatically sending the selected text to a designated set of recipients in response to receiving the user input selecting the text.
>
> However, Hager discloses the selected text or document is automatically transmitted to the preselected recipients (col. 2, lines 25-38 and col. 4, lines 25-37).
>
> Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur with the teachings of Hager so as to obtain a method for distributed the selected text document with a desired recipient from a list of recipients stored in the database (Nochur – col. 10, lines 1-10). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager – abstract) over a computer network within data processing system.

Office Action dated January 12, 2004, page 3.

Additionally, in comparing the cited references to the claimed invention, the claim limitations of the presently claimed invention may not be ignored in an obviousness determination.

Amended claim 1 reads as follows:

1.   A method in a data processing system for sharing text in an electronic book, the method comprising:
        receiving a user input selecting the text from the electronic book to form selected text; and
        automatically sending the selected text to a designated set of recipients in response to receiving the user input selecting the text.

In this particular case, all of the features in amended claim 1 are not found in *Nochur*. First, *Nochur* and *Hager* do not teach selecting text from an electronic book and automatically sending the selected text to each electronic book for a designated set of recipients in the manner recited in amended claim 1. More specifically, neither cited reference alone or in combination teach or suggest sending text selected from an electronic book automatically to electronic books for a set of recipients in which the text is automatically sent in response to a user input selecting the text in a electronic book.

Further, the text selected in the cited portion of *Nochur* is not the same text that is sent to other recipients in the other cited portion of *Nochur*. In other words, the selecting step pointed out by the examiner in *Nochur* is described in reference to selecting text that is to be placed into an element in a map, while the portion of *Nochur* cited for sending the selected text discloses sending documents to recipients, rather than selected text.

For example, the examiner points to the following section of *Nochur* as teaching the selection of text:

> The descriptive text attribute for an item can be entered or edited by selecting the text editing tool from tool bar 23 and selecting the item. When the user selects the edit tool, visual interface manager 20 receives a message about the tool selection and passes it to map view manager 32. Once the item is selected for text entry, the user can enter descriptive text and click the right button of the mouse to deselect the text edit tool. On deselection, map view manager 32 receives the deselection message and passes the text entered to the item. The item, in turn, requests the database manager 25 via visual interface manager 20 to update its text in the database 28.
>
> Text module 212 (FIG. 2) allows the user to create and save text

documents. Text from a text document can be transferred to an item on a map by first selecting the text, then selecting the relevant element from palette 24, and placing it at the desired location on the map. Visual interface manager 20 is informed of the selection made on the text document by the text module 212. When an item is selected and placed on a map, map view manager 32 (in FIG. 3) queries visual interface manager 20 for the text to be transferred and sends a message to visual interface manager 20 which in turn sends a message to database manager 25 to save the text in database 28 as part of the item's attributes.

Nochur, column 7, lines 42-65. In this portion of *Nochur*, the cited reference teaches that text may be transferred from a document to an item on a map by first selecting the text, selecting the relevant element, and then placing it in the desired location on the map.

With respect to selecting text, the examiner also points to the following section of *Nochur*:

Users enter descriptive text, such as 66a, into an item, such as 66b after selecting the text mode icon 67a on tool bar 67. Text from existing computer-based documents, or from lists or text documents, can be transferred to an item on a map by first selecting the desired text, then selecting the desired element on palette 61, and then placing the cursor on the map where the item is to be located. Items can be connected with lines or arrows of various kinds, such as 67b and 67c to show how they are related in terms of sequence, cause-effect relationship, the flow of issues and ideas, hierarchy, etc.

Nochur, column 11, lines 42-53. In this example, text may be entered and transferred to an item on a map. In both cited sections, text is transferred to a map, which is not an electronic book as recited in claim 1.

In the sections of *Nochur* cited for transferring text, a document attached to a message is forwarded to other recipients, but this document is not the same as the text described in the sections in *Nochur* cited for selecting text. Moreover, these cited portions of *Nochur* do not teach sending text to each electronic book for a designated set of recipients as recited in claim 1.

For example, the cited portion of *Nochur* for the sending step is found in the following portion of *Nochur*:

Messaging module 206 displays a memo form and attaches the relevant source document to it automatically. The user selects the list of recipients from a list of people available in database 28. When a memo is sent,

messaging module 206 sends a message to database manager 25 to save an
instance of the memo, and sends a trigger to each of its recipients
informing them about it. It also saves a reference to the memo in the
creator's out-basket. When a recipient acknowledges a memo trigger, all
the memos sent to him are received and references to each of them is
saved in the recipient's in-basket. Recipients can reply or respond to
memos. The user can go to the objects attached to a memo via visual
interface manager 20.

Nochur, column 9, line 65-column 10, line 10. This portion of *Nochur* teaches allowing a
user to attach a document to a message and send that message to a list of recipients. This
portion of *Nochur* does not teach sending selected text to electronic books as recited in
claim 1.

The first portions of *Nochur* cited by the examiner teach entering text and
transferring that text to an element in a map. On the other hand, the latter portion of
Nochur cited for sending text teaches attaching a document to a memo and sending that
memo to a list of recipients. The text in these cited portions are different types of text. In
one portion, the text placed or transferred to a element in a map, while the other portion
of *Nochur* teaches transferring a document to a recipient.

Therefore, the receiving step and the part of the sending step believed to be taught
in *Nochur* is not present because the cited sections teach manipulating text for different
purposes within the same reference. In one case in *Nochur*, the text is selected from a
document or entered and transferred to an element. In the other instance in *Nochur*, the
text is a document attached to a memo that is sent to recipients. To reach the steps of the
presently claimed invention, modifications to these teachings are required. No teaching,
suggestion, or incentive is present to modify these teachings in the manner needed to
reach the presently claimed invention.

Consequently, the teachings in these cited sections do not form the receiving and
sending steps in the manner characterized by the examiner. As a result, even if *Nochur*
could be combined with *Hager* as stated by the examiner, the combination would not
reach the presently claimed invention because *Nochur* does not teach the receiving step
or the sending step, without automatically sending, as stated by the examiner.

In addition, neither reference alone or in combination provides any teaching,
suggestion, or incentive for selecting text from an electronic book in the manner recited

in claim 1. In addition, neither reference alone or in combination provides any teaching, suggestion, or incentive for automatically sending the selected text in the electronic book to each electronic book for a set of designated recipients in the manner recited in claim 1 as amended.

Also, no teaching, suggestion, or incentive is present for combining *Nochur* and *Hager* as suggested by the examiner. The examiner has only stated that it would have been obvious to combine these references without providing any teaching, suggestion, or incentive for combining them in the manner recited by the examiner. In fact, one of ordinary skill in the art would not be motivated to combine these two references when they are considered as a whole by one of ordinary skill in the art. *Nochur* recognizes the following:

> Presently, people who want to represent and process, in a computer-based system, conceptual or physical entities of interest to them are limited to database, 4GL, and front-end development tools. While such tools make it possible to define various fields and records to describe entities and the relationships between, they do not allow the entities to be diagrammed visually in a way that shows how they are related in a sequence, hierarchy, structure, or other manner. Normative rules with regard to the attributes or relationships between various entities cannot be specified in a way that enables analysis of assemblages of such entities. Such tools do not allow communication or monitoring, over a computer-based network, of issues, topics, or situations that involve relationships between the entities of interest. The general-purpose invention that is described here overcomes these drawbacks and provides a complete system and method for representing, storing, processing, and communicating various conceptual and physical entities.

Nochur, column 1, lines 24-41. *Nochur* is concerned with limitations of tools, such as database and development tools with respect to communicating or monitoring topics.

The solution provided by *Nochur* is taught as follows:

> With a palette that they create, or with a previously defined palette, users create on a computer document, called a map in the present invention, specific instances, called items in the present invention, of one or more elements in the palette. Maps are stored and retrieved from computer-based storage devices. An item on a map typically comprises a visual or other representation of an element along with text and other attributes appropriate for its element category. Users can connect multiple items, if appropriate, with line segments, arrows, or other connectors to show the relationships between the items. A connection between two

items is referred to as a link in the present invention. Links may also be labeled in useful ways. A set of maps, along with other computer-based documents and objects associated with the maps, or associated with the items on the maps, may be indexed in a computer-based organizer, called a case in the present invention, for selection and retrieval. Data, visual, and other attributes may also be defined for the links between items, the maps on which the items and links are defined, and the cases which index the maps and other associated computer-based documents and objects. Associations and connections can be established between a map, or the items or links on it, and other maps and other computer-based documents or objects such as spreadsheets, word processor files, graphical objects, audio objects, and video objects.

Rules, heuristics, and norms may be specified in the present invention for the palette elements individually and for assemblages of them collectively. Based on such rules, heuristics, and norms, maps may be parsed to see if they are correct, consistent, and complete with regard to the items they contain and the relationships indicated by the links between them. Queries can be made and reports can be generated based on the data and other attributes defined for the items, links, maps, and cases. Items, links, maps, cases, and other computer-based documents and objects can be shared among various users on a computer network. Users can send messages to each other over the network, along with attachments of or references to items, links, maps, cases, and other computer-based documents and objects of interest.

Nochur, column 3, line 37-column 4, line 10. As can be seen, the solution provided by *Nochur* involves generating a map with elements that may be connected to each other using links. Queries may be made to one or more maps based on different attributes defined for the links, maps, and other objects.

In contrast, *Hager* is directed toward the following problem:

Despite the advent of widespread electronic communication, selected activities within the traditional paper office have been difficult to implement in an electronic society. For example, the distribution of electronic documents in known electronic offices must be accomplished by manually entering a desired list of recipients and thereafter transmitting the electronic document to the listed recipients. Groups of desired recipients may be preselected and listed together; however, manual selection of a group of recipients is still required.

In selected applications it is often desirable to automatically transmit an electronic document to a predetermined list of recipients. For example, invention disclosure documents must generally be evaluated to determine whether or not the invention described therein merits the filing

of a patent application, a publication of the material contained therein or the closing of the file which contains the disclosure. In such instances, it is necessary and desirable to transmit these invention disclosure documents to one or more skilled evaluators who are knowledgeable in a specific functional area, in order to obtain an accurate evaluation.

In addition to invention disclosures many companies now encourage employees to submit written suggestions to cut costs or otherwise improve the efficiency of the company. These suggestions must also be routed to one or more skilled evaluators for appraisal.

It should therefore be apparent that a need exists for a method and system whereby electronic documents stored within a data processing system may be automatically distributed to a preselected list of recipients.

Hager, column 1, line 44-column 2, line 6. *Hager* is concerned with problems in

distributing documents to recipients.

Hager teaches the following solution to this problem:

The method and apparatus of the present invention permit the automated distribution of an electronic document to a preselected list of recipients. A selected document is identified and a document profile is selected or created, including an identification of the technical or functional area disclosed within that document. An examination of the document profile is then utilized to determine a preselected group of recipients and the document is automatically transmitted to those recipients. In one embodiment of the present invention, the creator of each document is prompted to select one or more functional areas from a predetermined list of functional areas during the creation of a document. In still another embodiment, the functional area of a document is automatically established in response to an examination of the department number, division, building, laboratory group, et cetera associated with the creator or creators of the document.

Hager, column 2, lines 21-38. This solution, in *Hager*, provides for distributing

electronic documents to recipients based on examining a document profile to

automatically transmit the document to a preselected group of recipients.

Thus, these two references are directed towards different problems and solutions

when they are considered as a whole by one of ordinary skill in the art. As a result, no

teaching, suggestion, or incentive is present for combining these references in the manner

recited by the examiner. The combination of modifications to these two references can

only be made through an improper use of hindsight with the benefit of applicant's

disclosure as a template to piece together the teachings needed to reach the presently claimed invention in amended claim 1.

Therefore, the rejection of claims 1-2, 9-12, 23 and 26-27 under 35 U.S.C. § 103 have been overcome.

II.   35 U.S.C. § 103(a), Obviousness, claims 3-8, 13-22, and 24-25

The examiner has rejected claims 3-8, 13-22, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over Nochur et al., U.S. Patent Number 5,835,758 (*"Nochur"*) in view of Hager et al., U.S. Patent Number 5,247,661 (*"Hager"*) and further in view of Huffman et al., U.S. Patent Number 5,893,132 (*"Huffman"*). This rejection is respectfully traversed.

With respect to claims 3-8, these claims are patentable over the cited references for the same reasons as amended independent claim 1. As stated previously, neither *Nochur* nor *Hager* teach or suggest receiving user input, selecting text from an electronic book, or automatically sending the selected text to each electronic book for a set of recipients. Further, the receiving and sending steps pointed to by the examiner in *Nochur* are directed towards different types of text selected for different purposes as discussed above. Therefore, a combination of *Huffman* with these references also would not reach the presently claimed invention.

In rejecting claim 13, the examiner stated the following:

> With respect to claim 13, Nochur discloses receiving a first user input selecting the text from the electronic book to form selected text (the user enters the text document and selects the desired text to be transferred: col. 7, lines 42-65 and col. 11, lines 42-53), displaying a list of recipients (col. 9, lines 61-67).
>
> Nochur discloses a distributed computer system comprising a plurality of computer-based documents, which can be shared among various users on the network. The text document or selected text can be sent or forwarded to other users or recipients who are listed from a list of people available in database and are selected by the sender (col. 9, lines 65-67 and col. 10, lines 1-10). Nochur does not explicitly teach automatically sending the selected text to a designated set of recipients in response to receiving the user input selecting the text.. Hager teaches the selected text or document is automatically transmitted to the preselected

recipients (col. 2, lines 25-38 and col. 4, lines 25-37). In combination, Nochur and Hager do not explicitly indicate receiving a second user input.

However Huffman discloses receiving a second user input (col. 17, lines 45-58).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur in view of Hager with the teachings of Huffman so as to obtain a hand-held electronic reading devices incorporating with user interface, which allows a user to navigate through the textual information and access various features of electronic reading device (col. 2, lines 24-42 and col. 16, lines 5-14); highlight feature in the electronic book and performing different fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col. 23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and sending or transmitting the text to the user (col. 6, lines 26-36). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager-abstract) and a method for distributed the selected text document with a desired recipient from a list of recipients stored in the database (Nochur – col. 10, lines 1-10) over a computer network within data processing system.

Office Action dated January 12, 2004, pages 6-8. First, *Nochur* and *Hager* do not teach the features of claim 13 as believed by the examiner. The deficiencies in these teachings are pointed out in the section above with respect to independent claim 1 and the features in this claim that are similar to those in claim 13.

Amended claim 13 reads as follows:

13. A method in a data processing system for sharing highlighted text in an electronic book, the method comprising:
    receiving a first user input selecting the highlighted text from the electronic book;
    displaying a list of recipients;
    receiving a second user input selecting a designated set of recipients from the list recipients; and
    sending the highlighted text to each electronic book for the designated set of recipients.

As amended, claim 13 includes the features of (1) receiving a first user input selecting the highlighted text from the electronic book and (2) sending highlighted text to each electronic book for the designated set of recipients.

The cited sections of *Nochur* do not teach or suggest sending the text to electronic books for the designated set of recipients as recited in amended claim 13. The section of *Hager* cited by the examiner also does not teach or suggest automatically sending text to electronic books for a designated set of recipients as recited in amended claim 13. *Huffman* is cited for teaching the receipt of a second user input. This reference also does not teach or suggest sending text selected from an electronic book to other electronic books for a set of designated recipients.

In rejecting claim 14, the examiner stated the following:

> With respect to claim 14, Nochur discloses receiving selected text from at least one electronic book through a communications link (see abstract and col. 7, lines 10-67)., and displaying the text or selected text (col. 8, lines 12-24 and col. 9, lines 1-12).
>
> Nochur discloses a distributed computer system comprising a plurality of computer-based documents, which can be shared among various users on the network. The text document or selected text can be sent or forwarded to other users or recipients who are listed from a list of people available in database and are selected by the sender (col. 9, lines 65-67 and col. 10, lines 1-10) and sorting the data and displaying the data. Nochur does not explicitly teach sorting the selected text using selection criteria to form sorted text. Hager teaches sorting the text based on criteria such as functional area field of a file (col. 7, lines 55-65). In combination, Nochur and Hager do not teach highlighting the portion of the electronic book based n the user input.
>
> However, Huffman discloses wherein the selected text is highlighted text. (col. 19, lines 1-20 and col. 23, lines 25-36; web page having HTML or hyperlinks or hypertext: col. 19, lines 1-20; also see col. 16, lines 5-14 and col. 19, lines 1-20).
>
> Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Nochur in view of Hager with the teachings of Huffman so as to obtain a hand-held electronic reading devices incorporating with user interface, which allows a user to navigate through the textual information and access various features of electronic reading device (col. 2, lines 24-42 and col. 16, lines 5-14); highlight feature in the electronic book and performing different fonts and sizes on the plurality of words (col. 18, lines 60-67, col. 19, lines 1-20 and col. 23, lines 25-30) and downloading the text from web page (col. 12, lines 55-65) and sending or transmitting the text to the user (col. 6, lines 26-36). This combination would have made a method in a data processing system being able to create or select a text document in order for automatically sending or forwarding to the receiver(s) (Hager – abstract) and a method for distributed the selected text document with a

desired recipient from a list of recipients stored in the database (Nochur – col. 10, lines 1-10) over a computer network within data processing system.

Office Action dated January 12, 2004, pages 8-9.

Claim 14 has been amended to state that the selected text is received from at least one remote electronic book through a communications link to the data processing system in which these steps are executed. This text is then processed and displayed in the electronic book located in the data processing system. The processing includes sorting the selected text using a selection criteria. These features are not taught or suggested by *Nochur* or *Hager* in the manner recited in amended claim 14.

The examiner points to the following portion of *Hager* as teaching the sorting step:

> Next, block 126 illustrates the accessing of the employee files for a determination of department/division data for the creator of the disclosure document. Of course, those skilled in the art will appreciate that in various corporate entities, the terms "department" and "division" may not be utilized and substitute terms may be appropriate. In either event the method and apparatus of the present invention presumes that a computer based employee file is available for the organization in question and that individuals within the organization are sorted within those files in accordance with functional areas.

Hager, column 7, lines 54-65. This portion of *Hager* teaches sorting individuals in a file. Nowhere, however, does *Hager* teach or suggest sorting selected text from an electronic book.

When these references are considered as a whole, one of ordinary skill in the art would not combine these references together in the manner proposed by the examiner. As described above, *Hager* is directed towards a automated document distribution system while *Nochur* is directed towards a method and apparatus for defining and describing data using links and associations. These two references are directed towards different problems and solutions. Therefore, one of ordinary skill in the art would not combine these two references together along with *Huffman* to reach the presently claimed invention. The presently claimed invention may be reached only through the improper use of hindsight with the benefit of the applicant's disclosure as a template for the needed changes.

The other claims rejected using these references depend from independent claim 14 or are independent claims containing similar features. Therefore, these claims are also patentable over the cited references. Further, these claims also include other features not taught or suggested by the cited features. For example, claim 21 reads as follows:

> 21.   The method of claim 14, wherein the selection criteria is received with the selected text.

These features are not taught or suggested by the cited sections of *Nochur* as believed by the examiner. *Nochur* teaches the following in the cited section:

> In report definition module 13, users specify the formats 131 for various reports that they want to create, based on the attributes defined earlier for items, maps, links, cases, and text documents. This module also creates the query dialog boxes 133 users will need to define queries, and dialog boxes for selection and sorting 135 data for generating various standard and customizable reports.

Nochur, column 5, lines 59-65. As can be seen, this portion of *Nochur* provides no teaching, suggestion, or incentive for receiving selection criteria with the selected text.

The examiner also points to the following portion of *Nochur*:

> The user can attach other maps, text files, or other computer-based documents, to a particular map or to the items on it. When the user specifies the documents which are to be attached to the selected map or item, map view manager 32 sends a message to visual interface manager 20 to extract identification information from those destination documents which are then saved. A visual cue is generated to show that such attachments exist for the items. When the user double clicks on the cue, map view manager 32 sends a message to the item to give the list of attached documents and then displays the list. The user can select and load any attached document from the list. Map view manager 32 sends a message to visual interface manager 20 to load the document.

Nochur, column 8, lines 12-24. This portion of *Nochur* teaches displaying text. No teaching, suggestion, or incentive is present for receiving selection criteria with the selected text.

The examiner then points to the following portion of *Nochur*:

> ...interface manager 20 sends a message to report module 202 to display a dialog to select details of the report such as--the sources of information to

be included in the report and the fields and records to be queried. Report module 202 then defines the report, displays it to the user, and allows the user to print or save the report. When the user selects a command to load a saved report, visual interface manager 20 passes the command to report module 202 which displays all reports which have been saved. After the user selects the report module 202 to be loaded, the report loads it from secondary storage, extracts the required information, and displays it to the user.

Nochur, column 9, lines 1-12. This portion of *Nochur* teaches displaying information, but provides no teaching, suggestion, or incentive for receiving selection criteria with the selected text as recited in claim 21.

Similarly, the features in claim 22 of the present invention also are not taught or suggested by the cited reference as believed by the examiner. The cited sections do not teach that the sorted text excludes a portion of the selected text as recited in claim 22.

Therefore, the rejection of claims 3-8, 13-22, and 24-25 under 35 U.S.C. § 103(a) has been overcome.
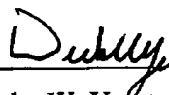

III.   **Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: February 11, 2004

Respectfully submitted,

Duke W. Yee
Reg. No. 34,285
Carstens, Yee & Cahoon, LLP
P.O. Box 802334
Dallas, TX 75380
(972) 367-2001
Attorney for Applicants

Page 19 of 19
Chastain et al. – 09/900,551